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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,610	10/28/2003	Mitchell Van Nguyen	03546	6865

7590
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12/27/2006

EXAMINER

CARLETON, THUY T

ART UNIT	PAPER NUMBER
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2196

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/696,610

Applicant(s)

NGUYEN, MITCHELL VAN

Examiner

Thuy Carleton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/28/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-10 are pending and have been examined.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Shiraishi et al. (US Patent 6,809,724), hereinafter "Shiraishi"

As claim 1, Shiraishi teaches an interface system for use in a pen-based computer having a touch-sensitive display screen (fig. 47A, label 680; col. 49, lines 10-17), at least one

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input button (fig. 1B, label 14B; col. 14, lines 7-9), a stylus pen (fig. 47A, label 603; col. 49, lines 10-17) and a memory based processor having a stored operating system therein (fig. 2, label 142, 144, col. 10, lines 44-49), said interface system comprising:

means for causing said processor to operate in a first mode (col. 4, lines 34-40);

means for causing said processor to operate in a second mode (col. 4, lines 34-40);

means for operating said processor in either said first or second modes (col. 4, lines 34-40);

and a button for controlling said means for operating to allow a user to select said first mode or said second mode (fig 3, label 14A, 14B and 14C; col. 4, lines 34-40; col. 17, lines 19-21).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi in view of Hinckley et al. (US Patent 6,690,365), hereinafter "Hinckley"

As claim 2, Shiraishi further teaches first mode is a write mode (fig. 8A; col. 14, lines 63-65).

Shiraishi does not teach second mode is a pan mode.

However, Hinckley teaches second mode is a pan mode (col. 12, lines 47-61).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify Shiraishi by having second mode is a pan mode as taught by Hinckley in order to

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configure and associate specific modes or functions to buttons on the hand-held computer and switch between operation modes utilizing the fingers to push the button(s), enabling ease of use by the operator.

As claim 3, Shiraishi further teaches the button is a normally open momentary contact switch (fig 3, label 14A, 14B and 14C; col. 17, lines 19-21). It is inherent that a button contained on a portable hand-held computer device can be an open momentary contact switch, where the user must push and hold to activate the desired function or mode.

As claim 4, Shiraishi does not teach the write mode is selected when said button is open and said pan mode is selected when said button is pressed and closed.

However, Hinckley teaches the write mode is selected when said button is open and said pan mode is selected when said button is pressed and closed (col. 12, lines 47-56).

Therefore, it would have been obvious to one ordinary skill in the art the time invention to modify Shiraishi by selecting the write mode when said button is open and said pan mode is selected when said button is pressed and closed as taught by Hinckley in order to alternate the modes by pressing and holding down on a button, while the user completes the desired action, enhancing the speed of inputting the data entry or panning (scrolling) the screen.

As claim 5, Shiraishi teaches an interface system for use in a pen-based computer having a touch-sensitive display screen (fig. 47A, label 680; col. 49, lines 10-17) and stylus pen (fig. 47A, label 603; col. 49, lines 10-17) together with a processor for writing upon said display screen (col. 42, lines 52-53), said interface system comprising:
a button for user selection between operations of writing or panning (fig 3, label 14A, 14B and 14C; col. 4, lines 34-40; col. 17, lines 19-21).

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Shiraishi does not teach the pen is moved upon said display screen and for panning a screen image in response to pen movement of said pen upon said display screen, means for causing said processor to implement writing in response to said button being non activated, and means for causing said processor to implement panning in response to said button being activated.

However, Hinckley teaches the pen is moved upon said display screen and for panning a screen image in response to pen movement of said pen upon said display screen (col. 2, lines 10-20);

means for causing said processor to implement writing in response to said button being non activated (fig. 8A col. 14, lines 63-65);

and means for causing said processor to implement panning in response to said button being activated (fig. 8A col. 14, lines 63-65).

Therefore, it would have been obvious to one ordinary skill in the art the time invention to modify Shiraishi by when the pen is moved upon said display screen and for panning a screen image in response to pen movement of said pen upon said display screen and causing said processor to implement writing in response to said button being non activated and causing said processor to implement panning in response to said button being activated as taught by Hinckley in order make the hand-held touch screen device more user friendly by switching modes with a finger push of a button and utilizing the stylus (pen) to move (pan or scroll) the document displayed on the screen.

As claim 6, Shiraishi does not teach the pan mode is selected when said button is open and said write mode is selected when said button is pressed and closed.

However, Hinckley teaches the pan mode is selected when said button is open and said write mode is selected when said button is pressed and closed (col. 12, lines 47-56).

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Therefore, it would have been obvious to one ordinary skill in the art the time invention to modify Shiraishi by selecting the pan mode when said button is open and said write mode is selected when said button is pressed and closed as taught by Hinckley in order to alternate the modes by pressing and holding down on a button, while the user completes the desired action, enhancing the speed of entering the data or panning the screen.

As claim 7, Shiraishi further teaches the button is a normally closed momentary contact Switch (fig 3, label 14A, 14B and 14C; col. 17, lines 19-21). It is inherent that a button contained on a portable hand-held computer device can be a closed momentary contact switch (e.g., laptop on/off type button), where the user must push and release to activate the desired function or mode, and repeat the same function to deactivate the function or mode.

As claim 8, Shiraishi teaches an interface system for use in a pen-based computer having a touch sensitive display screen (fig. 47A, label 680; col. 49, lines 10-17) and stylus pen (fig. 47A, label 603; col. 49, lines 10-17) together with a processor for writing upon said display screen (col. 42, lines 52-53), said interface system comprising:
a button for user selection between operations of writing or panning (fig 3, label 14A, 14B and 14C; col. 4, lines 34-40; col. 17, lines 19-21).

Shiraishi does not teach the pen is moved upon said display screen and for panning a screen image in response to pen movement of said pen upon said display, means for causing said processor to implement writing in response to said button being activated and means for causing said processor to implement panning in response to said button being non activated.

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However, Hinckley teaches the pen is moved upon said display screen and for panning a screen image in response to pen movement of said pen upon said display screen (col. 2, lines 10-20);

means for causing said processor to implement writing in response to said button being activated (fig. 8A; col. 14, lines 63-65);

and means for causing said processor to implement panning in response to said button being non activated (fig. 8A col. 14, lines 63-65).

Therefore, it would have been obvious to one ordinary skill in the art the time invention to modify Shiraishi by when the pen is moved upon said display screen and for panning a screen image in response to pen movement of said pen upon said display screen and causing said processor to implement writing in response to said button being activated and causing said processor to implement panning in response to said button being non activated as taught by Hinckley in order make the hand-held touch screen device more user friendly by switching modes with a finger push of a button and utilizing the stylus (pen) to move (pan or scroll) the document displayed on the screen.

As claim 9, Shiraishi does not teach the write mode is selected when said button is open and said pan mode is selected when said button is pressed and opened.

However, Hinckley teaches the write mode is selected when said button is open and said pan mode is selected when said button is pressed and opened (col. 12, lines 47-56).

Therefore, it would have been obvious to one ordinary skill in the art the time invention to modify Shiraishi by selecting the write mode when said button is open and said pan mode is selected when said button is pressed and opened as taught by Hinckley in order and utilize the buttons on the hand-held computer to switch between operation modes utilizing the fingers to push the

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button, enabling ease of use by the operator, and also inherently teaching the type of button could be a closed momentary contact switch (e.g., laptop on/off type button) and the desired mode could be configured to utilize a specific button.

As claim 10, Shiraishi does not teach the pan mode is selected when said button is open and said write mode is selected when said button is pressed and opened.

However, Hinckley teaches the pan mode is selected when said button is open and said write mode is selected when said button is pressed and opened (col. 12, lines 47-56).

Therefore, it would have been obvious to one ordinary skill in the art the time invention to modify Shiraishi by selecting the pan mode when said button is open and said write mode is selected when said button is pressed and opened as taught by Hinckley in order and utilize the buttons on the hand-held computer to switch between operation modes utilizing the fingers to push the button, enabling ease of use by the operator, and also inherently teaching the type of button could be a closed momentary contact switch (e.g., laptop on/off type button) and the desired mode could be configured to utilize a specific button.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Okada (US Pub 2004/0100451) – Electronic apparatus and operation mode switch method.

Keely, Jr. et al. (US Patent 6,337,698) – Pen-based interface for a notepad computer.

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Lui et al. (US Pub 2003/0193484) – System and method for automatically switching between writing and text input modes.

Louis (US Patent 6,088,023) – Integrated pointing and drawing graphics system for computer.

Hinckley et al. (US Patent 7,061,474) – Automatic scrolling.

Rosenberg et al. (US Patent 7,148,875) – Haptic feedback for touchpads and other touch controls.

Yoshikawa (US Patent 5,790,105) – Pressure sensitive resistor tablet coordinate input device.

Gaultier et al. (US Patent 6,034,672) – Device for multimode management of a cursor on the screen of a display device.

Singh et al. (US Patent 6,400,376) – Display control for hand-held data processing device.

Allport (US Patent 6,757,001) – Method of using physical buttons in association with a display to access and execute functions available through associated hardware and software.

Lui et al. (US Patent 6,256,009) – Method for automatically and intelligently scrolling handwritten input.

Perlin (US Patent 6,031,525) – Method and apparatus for writing.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Carleton whose telephone number is 571-270-1258. The examiner can normally be reached on Monday-Friday (7:00AM-5:00PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC

Thuy Carleton


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